

## **REMARKS**

In response to the above-identified Office Action, Claims 1-8 and 11-18 amended, no claims are cancelled and Claim 21 is added. Accordingly, Claims 1-21 are pending and are rejected. Reconsideration and withdrawal of the rejections of record are requested in view of such amendments and the following discussion.

### **I. Claim Rejections Under 35 U.S.C. §112**

The Examiner rejects Claims 1-12 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Regarding Claim 1, the feature of Claim 1 referred to by the Examiner is amended to recite the following claim feature:

accessing, by the communication proxy, a web server to provide the Internet service to a client if the communication proxy is compatible with the client environment.

Applicants respectfully submit that this amended feature of Claim 1 particularly points out and distinctly claims the subject matter, which Applicants regard as the invention. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the 35 U.S.C. §112, second paragraph rejection of Claim 1, as well as Claims 2-5, which depend from Claim 1.

Regarding Claim 6, the feature recited by Claim 6 and referred to by the Examiner is amended as follows:

interacting with a web server using the downloaded communication proxy to receive the desired Internet service.

Applicants respectfully submit that Claim 6, as amended, particularly points out and distinctly claims the subject matter, which Applicants regard as the invention. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the 35 U.S.C. §112, second paragraph, rejection of Claim 6, as well as Claims 7-12, which depend from Claim 6.

### **II. Claim Rejections Under 35 U.S.C. §102(a)**

The Examiner rejects Claims 1-5 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,594,700 issued to Graham (“Graham”).

“Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” Lindemann Maschinenfabrik v. American Hoist & Derrick (“Lindemann”), 730 F.2d 452, 1458 (Fed. Cir. 1994)(emphasis added). Additionally, each and every element of the claim must be exactly disclosed in the

anticipatory reference. *Titanium Metals Corp. of American v. Banner* (“Banner Titanium”), 778 F.2d 775, 777 (Fed. Cir. 1985).

Regarding Claim 1, Claim 1 is amended to recite the following claim feature, which is neither taught nor suggested by either Graham or the references of record:

accessing, by the communication proxy, a web server to provide the Internet service to a client if the communication proxy is compatible with the client environment. (Emphasis added)

Applicants respectfully submit that the above-described feature of Claim 1, as amended, is neither taught nor suggested by either Graham or the references of record. Graham is directed to a method including a server provider protocol adapter servlet and a client protocol adapter servlet, which respectively listen for service advertisements and client look-up requests, which are converted into a canonical representation and stored within an internal registry. Once a client request is converted into a canonical representation of the request, the client protocol adapter servlet uses the canonical representation of the request to look up a service required by the client. Once a match has been found, the client protocol adapter servlet brokers the mechanism of client service provider interaction. (See Abstract.)

As further described within Graham:

the protocol of the requester client and the service provider are unimportant. In the present invention, a client may have a protocol which is the same as or different from the service provider because an interaction between the client and the service provider is brokered in a protocol independent internal registry 402. (Col. 6, lines 13-18.) (Emphasis added.)

Conversely, the communications proxy by which a client accesses a web server to receive an Internet service is required to be compatible with a client environment, as recited by amended Claim 1. Hence, Applicants respectfully submit that the explicit statement within Graham that “the protocol of the requester client and the service provider are unimportant” (See col. 6, lines 13 and 14) specifically prohibits the Examiner from establishing anticipation of the above-recited claim feature of Claim 1, as amended.

Accordingly, Applicants respectfully submit that Applicants’ amendment of Claim 1 prohibits the Examiner from establishing a *prima facie* case of anticipation of Claim 1 by Graham since Graham teaches away from the communication proxy compatibility with a client environment, as recited by Claim 1. Therefore, Applicants respectfully submit that Claim 1, as amended, is patentable over Graham, as well as the references of record. Consequently, Applicants respectfully request that the Examiner reconsider and withdraw the §102(e) rejection of Claim 1.

Regarding Claims 2-5, Claims 2-5 depend from Claim 1 and therefore include the patentable claim features of Claim 1, as described above. Accordingly, Claims 2-5, based on their

dependency from Claim 1, are also patentable over Graham, as well as the references of record. Consequently, Applicants respectfully request that the Examiner reconsider and withdraw the §102(3) rejection of Claims 2-5.

Regarding Claims 6 and 17, Claims 6 and 17 are amended to include or recite the following claim feature, which is neither suggested nor taught by Graham or the references of record:

receiving metadata from the broker regarding a communication proxy having at least a matching communication proxy type to the desired communication proxy type. (Emphasis added.)

Applicants respectfully submit that the explicit statement within Graham indicating that “the protocol of the requester client and the service provider are unimportant” (See col. 6, lines 13-14) explicitly teach away from the above-recited claim feature of amended Claims 6 and 17. In other words, the claimed features reciting a communications proxy having a communication proxy type matching a desired communication proxy type are directed to compatibility between a requester client and a service provider client. Conversely, Graham specifically teaches away from such client and service provider compatibility.

Accordingly, Applicants respectfully submit that Applicants’ amendments of Claims 6 and 17 prohibit the Examiner from establishing a *prima facie* case of anticipation of Claims 6 and 17, as amended, since Graham fails to disclose each and every element of Claims 6 and 17, as amended. Accordingly, Claims 6 and 17, as amended, are patentable over Graham, as well as the references of record. Consequently, Applicants respectfully request that the Examiner reconsider and withdraw the §102(3) rejection of Claims 6 and 17.

Regarding Claims 7-12, Claims 7-12 depend from Claim 6 and therefore include the patentable claim features of Claim 6, as described above. Accordingly, Claims 7-12, based on their dependency from Claim 6, are also patentable over Graham, as well as the references of record. Consequently, Applicants respectfully request that the Examiner reconsider and withdraw the §102(3) rejection of Claims 7-12.

Regarding Claims 18-20, Claims 18-20 depend from Claim 17 and therefore include the patentable claim features of Claim 17, as described above. Accordingly, Claims 18-20, based on their dependency from Claim 17, are also patentable over Graham, as well as the references of record. Consequently, Applicants respectfully request that the Examiner reconsider and withdraw the §102(3) rejection of Claims 18-20.

Regarding Claim 13, Claim 13 is amended to recite the following claim feature, which is neither taught nor suggested by either Graham or the references of record:

receiving a request to locate a client-desired Internet service having a client-specified communication proxy type;  
matching the request with the Internet service registration to identify a communications proxy of the communication proxy type. (Emphasis added.)

Applicants respectfully submit that the above-recited claim feature of Claim 13, as amended, cannot be anticipated by Graham since Graham explicitly states that:

the protocol of the requester client and the service provider are unimportant.  
(See col. 6, lines 13-14.)

Applicants respectfully submit that the identification of a communication proxy of the client specified communication proxy type teaches away from the Graham reference. Accordingly, Applicants respectfully submit that Applicants' amendment of Claim 13 prohibits the Examiner from establishing a *prima facie* case of anticipation of Claim 13, since Graham, as well as the references of record, fail to disclose at least the recited claim features of Claim 13, as provided above. Accordingly, Applicants respectfully submit that Claim 13, as amended, is patentable over Graham, as well as the references of record. Consequently, Applicants respectfully request that the Examiner reconsider and withdraw the §102(e) rejection of Claim 13.

Regarding Claims 14-16, Claims 14-16 depend from Claim 13, and therefore include the patentable claim features of Claim 13, as described above. Accordingly, Claims 14-16, based on their dependency from Claim 13, are also patentable over Graham, as well as the references of record. Consequently, Applicants respectfully request that the Examiner reconsider and withdraw the §102(e) rejection of Claims 14-16.

### CONCLUSION

Applicant has amended the claims to recite features that are not taught or suggested by the references. No new matter is introduced by the Applicant's claim amendments, which are supported in Applicant's specification and are necessary for placing the present application in condition for allowance.

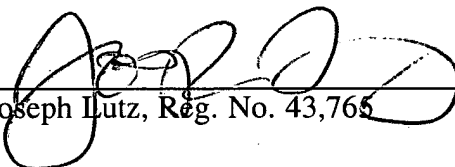
In view of the foregoing, it is believed that all claims now pending, namely Claims 1-20 patentably define the present application over the prior art of record, and are therefore in condition for allowance; and such action is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (310) 207-3800, ext. 738.

Respectfully submitted,

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#### **CERTIFICATE OF MAILING:**

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Marilyn Bass

June 23, 2004